

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES H. ALLEMAN

MAILED

Appeal No. 96-2121
Application 08/252,984¹

AUG 13 1998

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

ON BRIEF

Before BARRETT, LEE and CARMICHAEL, Administrative Patent Judges.
LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's non-final rejection of the twice rejected claims 18-27. Claims 1-17 have been canceled. No claim has been allowed.

References relied on by the Examiner

IDT machine disclosed in (1) Business Week article "Rome To Bonn Via New Jersey", issued April 13, 1992, and (2) Business Week article "How Overseas Callers Can Get Stateside Rates", issued December 2, 1991.

Kahn et al. (Kahn)	4,086,438	Apr. 25, 1978
Billinger et al. (Billinger)	4,769,834	Sep. 06, 1988
Srinivasan	5,185,782	Feb. 09, 1993

¹Application filed June 2, 1994.

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The Rejections on Appeal

Claims 18-27 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and specifically claim that subject matter which the appellant regards as his invention.

Claims 18 and 23 have been rejected under 35 U.S.C. § 102(a) as being anticipated by the IDT machine disclosed in the Business Week articles.

Claims 18-27 have been rejected under 35 U.S.C. § 103 as being unpatentable over the IDT machine disclosed in the Business Week articles.

Claims 18-27 have been rejected under 35 U.S.C. § 103 as being unpatentable over Kahn, Billinger, and Srinivasan.

The Invention

The invention is directed to a system and method for making a telephone connection between a caller outside of the United States to a called telephone station as if it were a call originating in the United States. There are two independent claims, i.e., claim 18, an apparatus claim, and claim 23, a process claim. Claim 18 is representative and is reproduced below:

18. A system for establishing a telephone communication link between a subscriber telephone station and a destination telephone station, both being connected through a telephone exchange, comprising:

control means operable for managing a database of caller information;

storage means connected to the control means and operable for storing the database of caller information including a preassigned direct inward dial telephone number associated with a subscriber and a subscriber telephone number associated with the subscriber telephone station;

first telephone connection means connected to the control means and operable for connecting through a trunk line to the telephone exchange and for receiving an incoming direct inward dial telephone number on the trunk line from the telephone exchange as part of an incoming call attempt from the subscriber telephone station, the incoming direct inward dial telephone number indicating the number called by the subscriber;

second telephone connection means connected to the control means and operable for dialing out through the telephone exchange;

the control means further operable for comparing the incoming direct inward dial telephone number to the preassigned direct inward dial telephone number and, if the incoming direct inward dial telephone number matches the preassigned direct inward dial telephone number associated with the subscriber, the control means is further operable for:

calling the subscriber remote telephone number through the first telephone connection means after the subscriber terminates the incoming call attempt and connecting to the subscriber telephone station;

receiving from the subscriber a calling telephone number for the destination station;

the second telephone connection means; and
for

bridging the first telephone connection means
to the second telephone connection means so
that the subscriber is connected to the
destination.

Opinion

The Indefiniteness Rejection

With regard to claim 18, the examiner objects to the appellant's use in claim 18 of the language "caller information." According to the examiner, the reference should, instead, be made to "subscriber information," since only a subscriber's information would be stored in the database. The examiner's view is misplaced. There is no requirement in the claim that every caller must have corresponding stored information in the database. Subscribers are a subset of all possible callers and thus are themselves callers. We see nothing indefinite about the appellant's defining that the database stores caller information.

With regard to line 22 of claim 18, the examiner asserts that the reference "the subscriber remote telephone number" has no antecedent basis. We disagree. The appellant correctly points out that the subscriber remote telephone number is the previously set forth subscriber number and it is inherently or naturally "remote" because the subscriber is connected through a telephone exchange. We are construing "remote" according to its broadest reasonable interpretation in the context of this

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invention. Note also that only a reasonable degree of precision and particularity is required. See, e.g., In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977).

With regard to both claim 18 and claim 23, the examiner objects to the appellant's reciting "connecting to the subscriber telephone station" as being indefinite. The examiner states that it is not clear what is being connected to the subscriber telephone station. We disagree. It is quite clear that in claim 18 it is the claimed system and in claim 23 the performer of the claimed method that is "connecting to the subscriber telephone station." In the answer, the examiner indicates that because the system of claim 18 has many components, the appellant must specifically recite which one is connecting to the subscriber telephone station. That is incorrect. The appellant need not recite the invention in more detail once it is made clear that the system is connecting to the subscriber telephone station. Breadth should not be confused with indefiniteness. In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

For the foregoing reasons, we do not sustain the rejection of claims 18-27 under 35 U.S.C. § 112, second paragraph.

The anticipation rejection

In Paper No. 26, dated January 20, 1995, the examiner stated in page 3 that claims 18 and 23 are rejected as being anticipated

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by the IDT machine disclosed in the Business Week articles and admitted by the appellant as prior art. Whether or not the appellant admitted that the IDT machine constitutes prior art is irrelevant. An admission is not necessary for the IDT machine to be regarded as prior art.

A plethora of evidence has been provided by the examiner to show or demonstrate that the IDT machine was in existence and operational in the United States more than one year prior to the "April 24, 1992" effective filing date of the appellant's application. See the examiner's answer at page 18 and Exhibit E1 attached to the examiner's answer. The appellant chose not to reply to this body of evidence and has not disputed that the IDT machine was in existence and operational in the United States more than one year prior to the appellant's effective filing date of April 24, 1992. On pages 16 to 17 of the answer, the examiner further noted that an article submitted by the appellant, "The Privateers: International Telephone Calls," The Economist, September 12, 1992 (copy attached), indicates that the IDT machine has been in operation for 2 and ½ years. In that regard, the appellant filed no reply and has not disputed the examiner's view.

It appears that the § 131 affidavit submitted by the appellant was only intended to antedate the Business Week articles rather than the IDT machine itself. But, as is

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clarified by the examiner on pages 14-15 of the answer, the prior art relied on is the IDT machine, and not the Business Week articles. Accordingly, since the IDT machine pre-dates the appellant's effective filing date by more than one year, the applicable provision of 35 U.S.C. § 102 is § 102(b) and thus the appellant may not antedate it by use of any § 131 affidavit. The IDT machine constitutes statutory-bar type of prior art under 35 U.S.C. § 102(b).

The appellant also incorrectly argues that the anticipation rejection is improperly based on more than a single prior art reference. The argument is misplaced, since the actual prior art in this case is the IDT machine, and not the two Business Week articles which discuss it. The Business Week articles merely are evidence of the pre-existence of the IDT machine, like the type of evidence presented by the examiner in his Exhibit E1. See, e.g., In re Epstein, 32 F.3d 1559, 1565, 31 USPQ2d 1817, 1821 (Fed. Cir. 1994).

Nonetheless, the IDT machine still must meet each and every feature of the invention claimed in claims 18 and 23 to support an anticipation rejection of those claims. In our view, the examiner has not established prima facie anticipation.

Each of claims 18 and 23 requires that an incoming direct inward dial telephone number be received from a telephone exchange as part of an incoming call attempt from the subscriber

telephone station, and that this received direct inward dial number be compared with preassigned direct inward dial telephone numbers stored in a database and associated with corresponding subscribers. When a match is found, a stored telephone number for that subscriber is used to call the subscriber. The examiner has not pointed to anything which indicates that this is how the IDT machine operates. It is not at all clear and it has not been established that the IDT machine makes use of incoming direct inward dial numbers generated by the telephone network or exchange, much less makes use of such in the same manner as is required by the appellant's claims.

There are many ways to ascertain the number of the calling station to call back a subscriber. For instance, the caller identification information provided by the telephone network or exchange may be used. Alternatively, there may be a dedicated line per subscriber, and if the line rings the caller is simultaneously identified. According to the New York Times article referenced on page 4 of the appellant's specification (copy attached), the IDT machine operates by having customers buy access to two telephone lines and by using a black box containing an automatic dialer and a device that makes conference calls possible. The IDT machine may have employed dedicated lines for each customer, like the acknowledged prior art described on pages 3-4 of the appellant's specification. Note that even the

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examiner has found, on page 7 of the answer, that the IDT machine provides each subscriber with a unique, dedicated input line. If that is the case, the IDT machine would have no need to receive and process an incoming direct input dial number provided by the telephone exchange.

For the foregoing reasons, we do not sustain the rejection of claims 18 and 23 under 35 U.S.C. § 102 as being anticipated by the IDT machine.

The obviousness
rejection over the IDT machine

The examiner has failed to demonstrate that the IDT machine reasonably would have suggested making use of the incoming direct inward dial number provided by a telephone network or exchange to identify the calling subscriber and to search for a corresponding telephone number for the subscriber. There exists no reasonable explanation as to why in light of the IDT machine the features of the appellant's claimed invention relating to use of the incoming direct inward dial number would have been obvious to one with ordinary skill in the art. The examiner presented no evidence to support a conclusion that the IDT machine would have reasonably suggested making use of the direct inward dial number provided by the telephone network or exchange to identify the calling subscriber and to ascertain the subscriber's number by searching a database of preassigned direct inward dial numbers.

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Additionally, the examiner has found (answer at 7) that the IDT machine operates by using unique dedicated lines for each subscriber. That is how the prior art as acknowledged by the appellant in the specification operates. It has not been explained how that would have reasonably suggested the appellant's claimed invention.

For the foregoing reasons, we do not sustain the rejection of claims 18-27 under 35 U.S.C. § 103 as being unpatentable over the IDT machine.

The obviousness rejection over
Kahn, Billinger, and Srinivasan

This combination of references still lacks a reasonable suggestion for using the incoming direct inward dial number provided by the telephone network or exchange to identify the caller and to ascertain the caller's number by searching a database of preassigned direct inward dial numbers. Srinivasan, apparently relied on by the examiner for this feature, discloses a system which collects both the automatic number identification information (ANI) and direct inward dial number (DID) provided by the telephone network or exchange, but uses only ANI which indicates the calling number to search a database to determine if the caller is a valid account-holder. See Srinivasan in column 6, lines 5-17. The examiner cites Srinivasan only for teaching

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use of ANI and DID in telecommunication services (answer at 10). However, the appellant's claimed invention is much more specific. In the appellant's claimed invention, it is the direct inward dial number received from the exchange that is used for looking up a database of preassigned direct inward dial numbers, for finding out the telephone number of the caller. It has not been shown that this is not suggested by any reasonable combination of Kahn, Billinger and Srinivasan.

Kahn discloses a call back system wherein the caller has to manually enter a security code for identification. Billinger discloses the use of ANI, automatic information on the number of the calling party, not DID, information on the number called, to ascertain the identity of a calling subscriber on a resell telephone communications system. Srinivasan, as described above, does not teach look up of any preassigned list of direct inward dial numbers to ascertain the identity or call back number of the calling party. The combination of these references do not reasonably suggest the appellant's claimed invention.

In footnote 3 in the answer, the examiner makes further reference to other items of prior art. It should be noted, however, that these references were not positively stated or

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otherwise included in the rejection and thus cannot be properly relied on to show a missing feature. In re Hoch. 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). In any event, the examiner has not asserted that any of these items of prior art discloses using the direct inward dial number provided by the telephone network or exchange to identify a calling subscriber and for searching a database of preassigned direct inward dial numbers to ascertain the subscriber's telephone number or other personal information. We cannot simply assume that they do.

For the foregoing reasons, we do not sustain the rejection of claims 18-27 under 35 U.S.C. § 103 as being unpatentable over Kahn, Billinger, and Srinivasan.

Conclusion

The rejection of claims 18-27 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and specifically claim that subject matter which the appellant regards as his invention, is reversed.

The rejection of claims 18 and 23 under 35 U.S.C. § 102(a) as being anticipated by the IDT machine disclosed in the Business Week articles is reversed.²




² It should be noted, however, that this rejection should be stated as being under 35 U.S.C. § 102(b), not § 102(a).

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The rejection of claims 18-27 under 35 U.S.C. § 103 as being unpatentable over the IDT machine disclosed in the Business Week articles is reversed.

The rejection of claims 18-27 under 35 U.S.C. § 103 as being unpatentable over Kahn, Billinger, and Srinivasan is reversed.

REVERSED


LEE E. BARRETT)
Administrative Patent Judge)

JAMESON LEE)
Administrative Patent Judge)

JAMES T. CARMICHAEL)
Administrative Patent Judge)

BOARD OF PATENT
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